

REMARKS

Claims 1-29 stand rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent Publication No. 2004/0045030 A1 (“Reynolds”). Applicants respectfully traverse the rejection for at least the reasons as set forth below.

Applicants respectfully challenge each and every taking of Official Notice and/or the conclusory assertions of what is allegedly well known in the Office Action without providing any supporting documentary evidence.

Applicants respectfully challenge the taking of Official Notice and/or the conclusory assertions of what is allegedly well known in the Office Action Made Final, without providing any supporting documentary evidence, as being improper under normal Final Rejection practice.

The Manual of Patent Examining Procedure (“M.P.E.P.”) cautions that “[w]hile ‘official notice’ may be relied on, these circumstances should be *rare* when an application is under final rejection or action under 35 CFR 1.113”. See M.P.E.P. § 2144(A) (emphasis added). It is respectfully submitted that this is not one of those “*rare*” circumstances when Official Notice may be used or at least, the Office Action does not state a reason why the present application must be classified as a “*rare*” circumstance as understood in the M.P.E.P. when Official Notice may be used.

Accordingly, Applicants respectfully submit that it is improper under normal Final Rejection practice under M.P.E.P. § 2144(A) for the Office Action Made Final (i.e., the application under Final Rejection) to have relied on Official Notice or to have made conclusory assertions, without documentary evidence, of what is allegedly well known.

Therefore, for at least the above reasons, Applicants respectfully request that a subsequent Office Action be issued in which the subsequent Office Action does not rely upon Official Notice in attempting to present a *prima facie* case of obviousness.

Applicants respectfully request that the Examiner produce references in support of the Examiner’s contention or, if the Examiner is relying upon personal knowledge to support the

finding of what is known in the art, then the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanations to support the finding. See, e.g., M.P.E.P. § 2144.03(C) and 37 C.F.R. § 1.104(d)(2). In any event, Applicants respectfully request that the Examiner frame the *prima facie* case of obviousness in terms of the modification of Reynolds in view of the newly cited documents, if applicable.

Therefore, for at least the above reasons, Applicants respectfully request that a subsequent Office Action be issued in which the subsequent Office Action does not rely upon Official Notice in attempting to present a *prima facie* case of obviousness.

Applicants respectfully challenge the taking of Official Notice and/or the conclusory assertions of what is allegedly well known, without providing any supporting documentary evidence, as being improper under because the Office Action impermissibly makes naked assertions of technical facts in the areas of esoteric technology.

M.P.E.P. § 2144.03(A) states that “assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art”.

The Office Action Made Final makes naked assertions of technical facts in an esoteric technology. In the esoteric technology of methods and systems for adapting media content, the Office Action Made Final impermissibly makes naked assertions of technical facts.

For example, on page 3 of the Office Action Made Final, technical facts are asserted, without any supporting documentary evidence, with respect to communications devices in private homes and media metadata in a file and possibly with respect to a media exchange network, a media exchange server and adapting media content, for example. On page 5 of the Office Action Made Final, technical facts are asserted, without any supporting documentary evidence, with respect to coupling communication devices to a network via a satellite headend and a DSL headend, for example. On page 8 of the Office Action Made Final, technical facts are asserted, without any supporting documentary evidence, with respect to creating private media channels, pushing private

media channels and streaming content over networks and possibly creating permissions for content, for example. On page 10 of the Office Action Made Final, technical facts are asserted, without any supporting documentary evidence, with respect to a set-top box being replaced with a communications device that stores a revisable device profile and that receives a file associated with media content, for example. On page 11 of the Office Action Made Final, technical facts are asserted, without any supporting documentary evidence, with respect to where media content of the highest quality levels resides in a network, for example. Also, on page 11 of the Office Action Made Final, technical facts are asserted, without any supporting documentary evidence, with respect to where private media channels reside and possibly with respect to the creation of private media channels, for example. On page 13 of the Office Action Made Final, technical facts are asserted, without any supporting documentary evidence, with respect to replacing communications device with a second communications device that stores a revisable device profile, for example.

The M.P.E.P. cautions that “assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art ***must always be supported by citation to some reference work recognized as standard in the pertinent art***”. See M.P.E.P. § 2144.03(A) (emphasis added).

The attention of the Examiner is respectfully drawn to the fact that the citation to some “reference work” must be “recognized as standard in the pertinent art”.

Thus, it is respectfully requested that if the Examiner attempts to support the undocumented assertions, the Examiner must use a “reference work” that is “recognized as standard in the pertinent art”.

Applicants respectfully request that the Examiner issue a subsequent Office Action that provides citations to reference works that are recognized as standards in the pertinent art if the Examiner wishes to maintain the rejection under 35 U.S.C. § 103(a).

Applicants respectfully challenge the taking of Official Notice and/or the conclusory assertions of what is allegedly well known in the Office Action without providing any supporting documentary evidence that particular elements recited in independent claim 1 and/or the same or

similar elements recited in any other claims that were “rejected for substantially similar reasons”.

In impermissibly taking Official Notice and/or making conclusory naked assertions of what is allegedly well known, the Office Action errors in considering particular elements *in a vacuum* instead of considering particular elements *in the context* of the other elements recited in the claim and/or other elements recited in other claims related via dependency. Thus, in the context of the other elements recited in claim 1, it would not have been well known or obvious make the system for adapting media content as set forth in claim 1. Reynolds relates to a server and a client communicating. Reynolds does not relate to a media exchange network with a media exchange server, a first private home and second private home in which a second communications device in the second private home receives a device profile relating to a first communications device, adapts the media content based on the device profile of the first communications device and sends the adapted media content with a file associated with the media content to the first communications devices device in which the file includes information as where the media content of a highest quality level resides outside the first private home and the second private home. There is no evidence that one of ordinary skill in the art would modify Reynolds as set forth in claim 1. In addition, although the Office Action Made Final mentions “metadata” out of the blue, Reynolds is silent as to “metadata”. And event if Reynolds were not silent as to metadata, there is no mention in Reynolds of adapting media content with a “metadata” as suggested in the Office Action Made Final.

Applicants respectfully submit that such assertions of technical facts are “not capable of instant and unquestionable demonstration as being well-known”. See M.P.E.P. § 2144.03(A).

It is respectfully submitted that it is believed that the Examiner is improperly relying upon *present day* information and knowledge instead of properly considering information and knowledge as of the time of the effective filing date of the present application.

Applicants respectfully challenge the taking of Official Notice and/or the conclusory assertions of what is allegedly well known, without providing any supporting documentary

evidence, as being improper since the Office Action Made Final impermissibly appears to take notice as to the state of the art.

On pages 3 and 4 of the Office Action Made Final, the Examiner takes statements seemingly “out of thin air” as to the reason for the suggestion/motivation for making particular modifications of Reynolds. However, there is no evidence in support of the Examiner’s naked reasons for modifying Reynolds. Again, it is believed that the Examiner is improperly relying upon *present day* information and knowledge instead of properly considering information and knowledge as of the time of the effective filing date of the present application.

The M.P.E.P. cites *In re Eynde*, 480 F.2d 1364, 178 U.S.P.Q. 470 (C.C.P.A. 1973) for the proposition that “we reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.” See M.P.E.P. § 2144.03(A).

Applicants respectfully request that the Examiner issue a subsequent Office Action provides documentary evidence in support of the alleged state of the art if the Examiner wishes to maintain the rejection under 35 U.S.C. § 103(a).

For at least the above reasons, it is respectfully requested that the rejection under 35 U.S.C. § 103(a) be withdrawn with respect to claim 1 and any other claims that were “rejected for substantially similar reasons” and any other claims rejected due to dependency.

Applicants respectfully challenge the taking of Official Notice and/or the conclusory assertions of what is allegedly well known in the Office Action without providing any supporting documentary evidence that particular elements recited in claim 2 and/or the same or similar elements recited in any other claims that were “rejected for substantially similar reasons”.

In impermissibly taking Official Notice and/or making conclusory naked assertions of what is allegedly well known, the Office Action errors in considering particular elements *in a vacuum* instead of considering particular elements *in the context* of the other elements recited in the claim

and/or other elements recited in other claims related via dependency. Thus, in the context of the other elements recited in claim 2 and/or independent claim 1 from which claim 2 depends, it would not have been well known or obvious make the system for adapting media content as set forth in claim 2. Thus, although a satellite headend or a DSL headend when considered *in a vacuum* might not be new, the combination of a satellite headend or a DSL headend with the other elements *in the context* of the claimed inventions as set forth in claim 2 and claim 1 are novel and nonobvious.

It is respectfully submitted that the Examiner might be improperly relying upon *present day* information and knowledge instead of properly considering information and knowledge as of the time of the effective filing date of the present application.

Applicants respectfully challenge the taking of Official Notice and/or the conclusory assertions of what is allegedly well known, without providing any supporting documentary evidence, as being improper since the Office Action Made Final impermissibly appears to take notice as to the state of the art.

On page 5 of the Office Action Made Final, the Examiner makes unsupported assertions with respect to the reason for the suggestion/motivation for making particular modifications of Reynolds. However, there is no evidence in support of the Examiner's naked reasons for modifying Reynolds. Again, it is respectfully submitted that the Examiner might be improperly relying upon *present day* information and knowledge instead of properly considering information and knowledge as of the time of the effective filing date of the present application.

The M.P.E.P. cites In re Eynde for the proposition that "we reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice." See M.P.E.P. § 2144.03(A).

Applicants respectfully request that the Examiner issue a subsequent Office Action provides documentary evidence in support of the alleged state of the art if the Examiner wishes to maintain the rejection under 35 U.S.C. § 103(a).

For at least the above reasons, it is respectfully requested that the rejection under 35 U.S.C. § 103(a) be withdrawn with respect to claim 2 and any other claims that were “rejected for substantially similar reasons” and any other claims rejected due to dependency.

Applicants respectfully challenge the taking of Official Notice and/or the conclusory assertions of what is allegedly well known in the Office Action without providing any supporting documentary evidence that particular elements recited in claim 13 and/or the same or similar elements recited in any other claims that were “rejected for substantially similar reasons”.

In impermissibly taking Official Notice and/or making conclusory naked assertions of what is allegedly well known, the Office Action errors in considering particular elements *in a vacuum* instead of considering particular elements *in the context* of the other elements recited in the claim and/or other elements recited in other claims related via dependency. Thus, in the context of the other elements recited in claim 13 and/or claim 1 from which claim 13 depends, it would not have been well known or obvious make the system for adapting media content as set forth in claim 13. Thus, although a communications device or a media channel or an authorized device, for example, when considered *in a vacuum* might not be new, the combination of a communications device or a media channel or an authorized device with the other elements *in the context* of the claimed inventions as set forth in claim 13 and/or claim 1 are novel and nonobvious,

It is respectfully submitted that it is believed that the Examiner is improperly relying upon *present day* information and knowledge instead of properly considering information and knowledge as of the time of the effective filing date of the present application. For example, the creation of private media channels and/or the pushing of private media channels as set forth in claim 13 appears to be an example of the Examiner improperly relying upon present day information and knowledge instead of properly considering information and knowledge as of the time of the effective filing date of the present application.

Applicants respectfully challenge the taking of Official Notice and/or the conclusory assertions of what is allegedly well known, without providing any supporting documentary

evidence, as being improper since the Office Action Made Final impermissibly appears to take notice as to the state of the art.

On page 8 of the Office Action Made Final, the Examiner makes naked assertions as to the reason for the suggestion/motivation for making particular modifications of Reynolds. However, there is no evidence in support of the Examiner's naked reasons for modifying Reynolds. Again, it is believed that the Examiner is improperly relying upon *present day* information and knowledge instead of properly considering information and knowledge as of the time of the effective filing date of the present application.

The M.P.E.P. cites In re Eynde for the proposition that "we reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice." See M.P.E.P. § 2144.03(A).

Applicants respectfully request that the Examiner issue a subsequent Office Action provides documentary evidence in support of the alleged state of the art if the Examiner wishes to maintain the rejection under 35 U.S.C. § 103(a).

For at least the above reasons, it is respectfully requested that the rejection under 35 U.S.C. § 103(a) be withdrawn with respect to claim 13 and any other claims that were "rejected for substantially similar reasons" and any other claims rejected due to dependency.

Applicants respectfully challenge the taking of Official Notice and/or the conclusory assertions of what is allegedly well known in the Office Action without providing any supporting documentary evidence that particular elements recited in claim 20 and/or the same or similar elements recited in any other claims that were "rejected for substantially similar reasons".

In impermissibly taking Official Notice and/or making conclusory naked assertions of what is allegedly well known, the Office Action errors in considering particular elements *in a vacuum* instead of considering particular elements *in the context* of the other elements recited in the claim and/or other elements recited in other claims related via dependency. Thus, in the context of the

other elements recited in claim 20 and/or claim 17 from which claim 20 depends, it would not have been well known or obvious make the system for adapting media content as set forth in claim 20. Thus, although a communications device or set-top box, for example, when considered *in a vacuum* might not be new, the combination of a communications device or a set-top box with the other elements *in the context* of the claimed inventions as set forth in claim 20 and/or claim 17 are novel and nonobvious. For example, the communications device is not merely replacing the set-top box in claim 20, but also stores a revisable device profile of the communications device, automatically sends the revisable device profile of the communications device to the network, and receives a file associated with the media content and the media content that has been adapted based upon the sent device profile of the communications device. In addition, the communications device must be considered, not only in the context of the other elements as set forth in claim 20, but also in the context of the system as set forth in claim 17 from which claim 20 depends.

It is respectfully submitted that the Examiner might be improperly relying upon *present day* information and knowledge instead of properly considering information and knowledge as of the time of the effective filing date of the present application.

Applicants respectfully challenge the taking of Official Notice and/or the conclusory assertions of what is allegedly well known, without providing any supporting documentary evidence, as being improper since the Office Action Made Final impermissibly appears to take notice as to the state of the art.

On page 10 of the Office Action Made Final, the Examiner makes naked assertions as to the reason for the suggestion/motivation for making particular modifications of Reynolds. However, there is no evidence in support of the Examiner's naked reasons for modifying Reynolds. Again, it is respectfully submitted that the Examiner might be improperly relying upon *present day* information and knowledge instead of properly considering information and knowledge as of the time of the effective filing date of the present application.

U.S. Application No. 10/675,377, filed September 30, 2003
Attorney Docket No. 14970US02
Response AF dated February 9, 2009 to Provoke Advisory Action
In Response to Office Action Made Final mailed December 8, 2008

The M.P.E.P. cites *In re Eynde* for the proposition that “we reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.” See M.P.E.P. § 2144.03(A).

Applicants respectfully request that the Examiner issue a subsequent Office Action provides documentary evidence in support of the alleged state of the art if the Examiner wishes to maintain the rejection under 35 U.S.C. § 103(a).

For at least the above reasons, it is respectfully requested that the rejection under 35 U.S.C. § 103(a) be withdrawn with respect to claim 20 and any other claims that were “rejected for substantially similar reasons” and any other claims rejected due to dependency.

Applicants respectfully challenge the taking of Official Notice and/or the conclusory assertions of what is allegedly well known in the Office Action without providing any supporting documentary evidence that particular elements recited in claim 29.

The same or similar arguments as were made with respect to claim 20 are also made, if applicable, with respect to claim 29.

For at least the above reasons, it is respectfully requested that the rejection under 35 U.S.C. § 103(a) be withdrawn with respect to claim 29 and any other claims that were “rejected for substantially similar reasons” and any other claims rejected due to dependency.

Applicants respectfully challenge the taking of Official Notice and/or the conclusory assertions of what is allegedly well known in the Office Action without providing any supporting documentary evidence that particular elements recited in claim 24 and/or the same or similar elements recited in any other claims that were “rejected for substantially similar reasons”.

In impermissibly taking Official Notice and/or making conclusory naked assertions of what is allegedly well known, the Office Action errors in considering particular elements *in a vacuum* instead of considering particular elements *in the context* of the other elements recited in the claim and/or other elements recited in other claims related via dependency. Thus, in the context of the

other elements recited in claim 24 and/or claim 22 from which claim 24 depends, it would not have been well known or obvious to perform the method for adapting media content as set forth in claim 24. Thus, although media content, for example, when considered *in a vacuum* might not be new, the combination of the media content as set forth in claim 24 with the other elements *in the context* of the claimed inventions as set forth in claim 24 and/or claim 22 is novel and nonobvious. For example, media content of the highest quality level resides in the network, but external to the first home and the second home is especially non-obvious in the context of the method for adapting media content as set forth in claim 22 from which claim 24 depends.

It is respectfully submitted that the Examiner might be improperly relying upon *present day* information and knowledge instead of properly considering information and knowledge as of the time of the effective filing date of the present application.

Applicants respectfully challenge the taking of Official Notice and/or the conclusory assertions of what is allegedly well known, without providing any supporting documentary evidence, as being improper since the Office Action Made Final impermissibly appears to take notice as to the state of the art.

On page 11 of the Office Action Made Final, the Examiner makes naked assertions as to the reason for the suggestion/motivation for making particular modifications of Reynolds. However, there is no evidence in support of the Examiner's naked reasons for modifying Reynolds. Again, it is respectfully submitted that the Examiner might be improperly relying upon *present day* information and knowledge instead of properly considering information and knowledge as of the time of the effective filing date of the present application.

The M.P.E.P. cites In re Eynde for the proposition that "we reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice." See M.P.E.P. § 2144.03(A).

Applicants respectfully request that the Examiner issue a subsequent Office Action provides

documentary evidence in support of the alleged state of the art if the Examiner wishes to maintain the rejection under 35 U.S.C. § 103(a).

For at least the above reasons, it is respectfully requested that the rejection under 35 U.S.C. § 103(a) be withdrawn with respect to claim 24 and any other claims that were “rejected for substantially similar reasons” and any other claims rejected due to dependency.

Applicants respectfully challenge the taking of Official Notice and/or the conclusory assertions of what is allegedly well known in the Office Action without providing any supporting documentary evidence that particular elements recited in claim 25 and/or the same or similar elements recited in any other claims that were “rejected for substantially similar reasons”.

In impermissibly taking Official Notice and/or making conclusory naked assertions of what is allegedly well known, the Office Action errors in considering particular elements *in a vacuum* instead of considering particular elements *in the context* of the other elements recited in the claim and/or other elements recited in other claims related via dependency. Thus, in the context of the other elements recited in claim 25 and/or claims 22 and 24 from which claim 25 depends, it would not have been well known or obvious to perform the method for adapting media content as set forth in claim 25. Thus, although a media channel, for example, when considered *in a vacuum* might not be new, the combination of the media channel as set forth in claim 25 with the other elements *in the context* of the claimed inventions as set forth in claim 25, claim 24 and/or claim 22 is novel and nonobvious. For example, creating private media channels in a communications device of a first home that is accessible only by a communications device of a second home in the context of the method for adapting media content as set forth in claims 24 and 22 from which claim 25 depends is new and nonobvious.

It is respectfully submitted that it is believed that the Examiner is improperly relying upon *present day* information and knowledge instead of properly considering information and knowledge as of the time of the effective filing date of the present application.

Applicants respectfully challenge the taking of Official Notice and/or the conclusory

assertions of what is allegedly well known, without providing any supporting documentary evidence, as being improper since the Office Action Made Final impermissibly appears to take notice as to the state of the art.

On pages 11 and 12 of the Office Action Made Final, the Examiner makes naked assertions as to the reason for the suggestion/motivation for making particular modifications of Reynolds. However, there is no evidence in support of the Examiner's naked reasons for modifying Reynolds. Again, it is respectfully submitted that the Examiner might be improperly relying upon *present day* information and knowledge instead of properly considering information and knowledge as of the time of the effective filing date of the present application.

The M.P.E.P. cites In re Eynde for the proposition that "we reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice." See M.P.E.P. § 2144.03(A).

Applicants respectfully request that the Examiner issue a subsequent Office Action provides documentary evidence in support of the alleged state of the art if the Examiner wishes to maintain the rejection under 35 U.S.C. § 103(a).

For at least the above reasons, it is respectfully requested that the rejection under 35 U.S.C. § 103(a) be withdrawn with respect to claim 25 and any other claims that were "rejected for substantially similar reasons" and any other claims rejected due to dependency.

Applicants do not necessarily agree or disagree with the Examiner's characterization of the documents made of record, either alone or in combination, or the Examiner's characterization of recited claim elements. Furthermore, Applicants respectfully reserve the right to argue the characterization of the documents of record, either alone or in combination, to argue what is allegedly well known, allegedly obvious or allegedly disclosed, or the characterization of the recited claim elements should that need arise in the future.

With respect to the present application, Applicants hereby rescind any disclaimer of

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claim scope made in the parent application or any predecessor or related application. The Examiner is advised that any previous disclaimer of claim scope, if any, and the alleged prior art that it was made to allegedly avoid, may need to be revisited. Nor should a disclaimer of claim scope, if any, in the present application be read back into any predecessor or related application.

In view of at least the foregoing, it is respectfully submitted that the present application is in condition for allowance. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge any additional fees, to charge any fee deficiencies or to credit any overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Date: February 9, 2009

Respectfully submitted,

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